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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,

Plaintiff,

vs.

GOOGLE, INC.,

Defendant.

Case No. C 10-3561 WHA

DR. KEARL'S RESPONSE TO ORACLE'S
STATEMENT REGARDING DR. KEARL'S
LACK OF COMPLIANCE WITH THE
COURT'S ORDER

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

By Order dated August 30, 2011 (Doc #374) Dr. Kearl was appointed in this case to serve as a Rule 706 expert. The procedures applicable to Dr. Kearl as a Rule 706 expert are set forth in the September 9, 2011 Order, Doc #413.

Dr. Kearl's appointment as a Rule 706 expert is consistent with the ruling of the Federal Circuit in *Monolithic Power Systems, Inc. v. 02 Micro International Limited*, 585 F.3d 1341 (Fed. Cir 2009).

By Order dated July 31, 2015 (Doc #1277) the Court ordered that "Any motions to disqualify Dr. Kearl are due by September 10, 2015." Google stipulated on September 10, 2015 (Doc #1309) to the continued engagement of Dr. Kearl as a Rule 706 expert. On September 10, 2015, Oracle filed "Oracle's Statement Regarding Dr. Kearl's Lack of Compliance (Doc #1311)

1 with the Court's Order." Oracle has not filed a motion to disqualify Dr. Kearl from serving as a
 2 court appointed Rule 706 expert.

3 Oracle complains that in response to this Court's Order of July 31, 2015 (Doc #1277) it
 4 received redacted copies of Dr. Kearl's report and testimony. Oracle makes this complaint
 5 notwithstanding that it failed to make an effort directed to the controlling parties to obtain timely
 6 compliance with the Protective Order in *Apple v. Samsung*. Exhibit 7 to September 10, 2015
 7 Declaration of Annette Hurst. Paragraph 14 on page 21 of that protective order provides:

8
 9 (a) If at any time Protected Material is subpoenaed by any
 10 court, arbitral, administrative, or legislative body, the Party to
 11 whom the subpoena or other request is directed shall immediately
 12 give prompt written notice thereof to every Party who has
 13 produced such Discovery Material and to its counsel and shall
 provide each such Party with an opportunity to move for a
 protective order regarding the production of Protected Materials
 implicated by the subpoena.

14 Both Apple and Samsung were notified in accordance with this provision of the July 31,
 15 2015 Order for production of Dr. Kearl's report and testimony in *Apple v. Samsung*. Neither
 16 party in response made a motion for a protective order, rather they worked together and stipulated
 17 to production of the redacted materials. The redacted materials were produced to the parties in
 18 this case on August 20, 2015. Dr. Kearl did not redact a single thing and, as he indicated through
 19 counsel to Oracle, has absolutely no problem in providing parties to this litigation an unredacted
 20 version of his report and testimony should Apple and Samsung agree to do so. Absent some
 21 relief from the *Apple v Samsung* protective order, however, Dr. Kearl is not at liberty to produce
 22 an unredacted version of his report and testimony. Oracle knew on August 20 that portions of the
 23 materials produced had been redacted. Oracle did not initiate discussion with counsel for Dr.
 24 Kearl until September 2, 13 days later. On September 3 counsel for Dr. Kearl responded to
 25 counsel for Oracle informing her that the materials produced were the result of stipulation
 26 between Apple and Samsung, Exhibit 6 to September 10, 2015 Declaration of Annette Hurst.
 27 Counsel for Dr. Kearl provided Oracle with contact information for counsel for Apple and
 28

1 Samsung. One of the counsel for Apple, Morrison Foerster, is counsel for Oracle in the present
 2 case, thus communication would not have been difficult.

3 There is no suggestion that counsel for Oracle has contacted counsel for Apple or
 4 Samsung to comply with paragraph 14 of the *Apple v. Samsung* protective order to seek an
 5 unredacted version of Dr. Kearl's materials. Counsel for Oracle repeatedly asked counsel for Dr.
 6 Kearl to ignore the provisions of the protective order in the *Apple v. Samsung* action and produce
 7 unredacted versions of Dr. Kearl's materials. There is time for Oracle to contact counsel for
 8 Apple and Samsung to seek compliance with paragraph 14 of the protective order in the *Apple v.*
 9 *Samsung* action if that is their desire. However, it appears that their real desire is not to obtain
 10 unredacted versions of Dr. Kearl's materials but to establish grounds to disqualify him. Dr.
 11 Kearl's failure to do Oracle's work is not grounds for his disqualification.

12 By Order dated September 9, 2011 (Doc #413) the Court provided that "The purpose of
 13 Dr. Kearl's appointment [as a Rule 706 expert] is to provide an independent professional
 14 analysis...." Notwithstanding that Dr. Kearl was retained and paid by Samsung in the *Apple v.*
 15 *Samsung* action, Oracle has made no showing that he was not an "independent" expert expressing
 16 his own professional opinion in that action as he has and will in the present action. It is common
 17 knowledge that expert witnesses are paid by one party or the other but that does not compromise
 18 their independence or professionalism in expressing their expert opinions. This is the case for Dr.
 19 Kearl as a Rule 706 expert as well as for the other expert witnesses for the parties in the present
 20 case. Oracle can fully probe Dr. Kearl's analysis and opinions in cross examination. See Order
 21 dated September 9, 2011, Doc #413.

22 The Federal Circuit in *Monolithic Power Systems, Inc. (supra)* addressed Oracle's
 23 expressed concern about any undue influence of a Rule 706 expert:

24 The district court properly exercised this discretion, taking care to instruct
 25 the jury that it should not assign Dr. Santi's [Rule 706] opinion greater
 26 inherent weight on accord of his independent status.

27 You should not give any greater weight to Professor Santi's
 28 opinion testimony than to the testimony of any other witness
 simply because the court ordered the parties to retain an

1 independent witness. In evaluating his opinion, you should
 2 carefully assess the nature of and basis for Professor Santi's
 3 opinion just as you would do with any other witness' opinion.

4 *Id. at p. 1347*

5 Oracle states that the *Apple v. Samsung* action was about Andriod. Oracle further states:

6 Thus, Oracle faces the prospect that Dr. Kearl's expenses were either
 7 reimbursed or subsidized in some material respect by Google because he
 8 was part of a broader strategy of defending Android—and that Dr. Kearl
 9 knows or suspects that is the case. See page 4 of Doc #1311.

10 Dr. Kearl in his August 13, 2015 response to request for comment, Doc. #1294, indicated that his
 11 analysis was focused solely on Samsung-owned patents asserted against Apple:

12 Moreover, since Dr. Kearl's analysis focused on the value of the asserted
 13 patents in the Apple products, to the degree that a mobile operating system
 14 or platform was relevant, that operating system would have been the
 15 Apple iOS operating system and not Android. See page 2 of Doc #1294.

16 As Dr. Kearl stated in his response to the Court's request for comment, Doc #1294, he
 17 was not involved in any "strategy of defending Andriod" in *Apple v. Samsung* – he was retained
 18 to value certain patents that Samsung asserted against Apple, nothing more. He further stated that
 19 his analysis in that matter was not directed to and did not relate to Android. He further stated that
 20 his involvement in that case does not create a conflict in the present action any more than his
 21 involvement in other cases unrelated to the present action.

22 **Daubert Motions**

23 Regarding his role in any Daubert motions, Dr. Kearl refers the Court and the parties to
 24 his August 13, 2015 Response to Request for Comment (Doc #1294).

25 Dated: September 14, 2015

26 FARELLA BRAUN + MARTEL LLP

27 By: /s/
 28 John L. Cooper

29 Attorneys for Rule 706 Expert,
 30 James R. Kearl